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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3676

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,953

Applicant(s)

BYRLA ET AL

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-22 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 4, 8, 23 and 24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. Review of the Prosecution indicates that withdrawal of certain rejections made under 35 USC 102 have left other claims improperly rejected under 35 USC 103.

Correction requires withdrawal of Finality of the previous Office Action to accommodate new grounds of rejection. Due to new grounds of rejection, this Office Action is not made Final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if or how the limitation defines the claimed method whereby the scope of the claim is rendered indefinite. Limitation of "disposable" is literally interpreted as 'capable of being disposed' and does not define any particular structure of the handle and 'as best understood', does not require an anticipatory reference to teach a "trunk lid" or "trunk space" for example, where the invention is a process for manufacturing a handle. It is unclear if or how functional capability of the handle further defines any currently-recited step in the process of manufacturing the handle, where it is that process that is claimed as the invention. Clarification is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 19, 25, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by United Kingdom Patent Application No. GB 2 264 436 to Amey.

Amey '436 teaches Applicant's claim limitations including : a "basic body" - 3,4, a "luminous body" - 5,6 mounted thereto as described.

Unlike claim 18 which positively recites the claimed invention to be 'arranged in a vehicle interior' it's noted that the 'vehicle interior space cover' and 'lock for the cover' do not form part of the invention of claim 19 for example. It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural

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limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). See MPEP 2114. It is the examiner's position that the handle of the reference is inherently capable of being used in a trunk space.

6. Claims 1, 9, 13, 17-19, 25, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,209,933 to Ang.

Ang '933 teaches Applicant's claim limitations for a passenger car including : an "unlocking handle" - 28 as shown in Fig 5, "basic body" - 60, "luminous body" - 62 which is mounted thereon in a two step injection molding process, a "vehicle interior space" - the vehicle trunk.

As regards claim 9, Ang '933 teaches "illuminating device" - 48 and "control" in Fig 4 where that light inherently provides "interior illumination" and reads on present alternative limitation.

7. Claims 1, 13, 17-19, 25, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,527,313 to Takahashi.

Takahashi '313 teaches Applicant's claim limitations for a passenger car including : an "unlocking handle" - 12 as shown in Fig 4, "basic body" - 16, "luminous body" - 17.

As regards claim 25, one of ordinary skill in the art would recognize that broadly-recited method steps are inherent to conventional manufacture of the structure

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disclosed by the prior art due to the particular arrangement of different materials in the finished product where those materials require separate manufacture and assembly.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 13, 18, 19, 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,445,326 to Ferro in view of United Kingdom Patent Application No. GB 2 264 436 to Amey.

Ferro '326 teaches providing a luminous handle for emergency unlocking of a vehicle trunk lid from interior of the trunk space. The reference discloses a luminous coating but not a distinct luminous body mounted onto a basic body as claimed. However, Amey '436 discloses that it is well known in the art of handles to use either a luminous coating, or luminous body made of luminous material mounted on a basic body for the purpose of making a handle luminous. It would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to provide a luminous handle on the device of Ferro '326 by forming a luminous portion distinct from a basic portion and mounting it thereto in order to reduce quantity of luminous material required for manufacture (as compared to forming the handle integrally from luminous material) and to increase durability of the luminous

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quality of the handle (as compared to luminous coating) as recognized by one having ordinary skill in the art. Furthermore, one of ordinary skill in the art would have more than a reasonable expectation of success since both means for obtaining a luminous handle are well known in the art of handles and the choice of either would not otherwise affect function of the device.

10. Claims 5, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,445,326 to Ferro in view of United Kingdom Patent Application No. GB 2 264 436 to Amey and further in view of WO 99/31171 to Hannacolor.

Although Ferro '326, as modified in view of Amey '436 does not teach the luminous body consisting of luminescent crystal mixture which is mixed with a transparent plastic material and/or is embedded therein, Hannacolor '171 teaches that it is well known to mold or extrude phosphorescent plastic articles from thermosetting resin and phosphorescent crystal pigments - see beginning page 3 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture the luminescent portion of the handle according to teachings of Hannacolor '171 in order to allow for indicia to be laser marked thereon, and since with or without laser marking it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,445,326 to Ferro in view of United Kingdom Patent Application No. GB 2 264 436 to Amey and further in view of U.S. Pat. No. 5,129,694 to Tanimoto.

Ferro '326, as modified in view of teachings of Amey '436 does not disclose "gluing" the luminous body onto the basic body. However, Tanimoto '694 discloses that it is well known in the art of handles to glue a softer material portion of the desired color onto a handle base portion in order to provide a strong handle with the desired color. Not to overstate the point, but one of ordinary skill in the art would recognize that luminescent plastic materials are inherently softer than metal base materials and that choice of luminescent plastic of yellow, green, blue, etc is by identity, a choice in color. It would have been an obvious design choice for one of ordinary skill in the art at the time of the invention to mount the luminous portion of the the handle of Ferro '326, as modified in view of Amey '436, by gluing as taught by Tanimoto '694 in order to securely retain the luminous portion to the underlying basic portion.

12. Claims 1, 2, 9, 10, 13, 14, 17-20, 25, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of U.S. Pat. No. 1,762,447 to Lowes.

Bingle '131 teaches Applicant's claim limitations including : a "passenger car" - see abstract, having an "unlocking handle" - 12. Bingle '131 teaches a luminescent handle at col 7, lines 11-14 but does not teach a distinct "basic body" and "luminescent body mounted thereon". However such handles are long known in the art as taught by

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Lowes '447 whereby it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a luminous handle for the device of Bingle '131 constructed from a basic body with a luminous body mounted thereon as taught by Lowes '447 in order to provide a handle made from a strong material and has luminescent feature to make it easy to locate in darkness.

As regards claim 2, the handle construction of Lowes '447 as relied upon reads on limitation of "dovetail guide" as shown in Fig 3 of that reference.

As regards claim 9, light inherently provides "interior illumination" and reads on present alternative limitation.

13. Claims 1, 2, 9, 10, 13, 14, 17-19, 25, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of United Kingdom Patent Application No. GB 2 264 436 to Amey.

Although Bingle '131 teaches a luminous trunk latch release handle, the reference does not explicitly teach separate luminous portion mounted on a base portion of the handle. However, Amey '436 discloses that it is well known in the art of handles to mount a luminous body made of luminous material on a basic body for the purpose of making a handle luminous. It would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to provide a luminous handle on the device of Bingle '131 by forming a luminous portion distinct from a basic portion and mounting it thereto in order to reduce quantity of luminous material required for manufacture (as compared to forming the handle

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integrally from luminous material) and to increase durability of the luminous quality of the handle (as compared to luminous coating) as would be recognized by one of ordinary skill in the art. Furthermore, one of ordinary skill in the art would have more than a reasonable expectation of success since both methods of obtaining luminosity are well known in the art of handles and the choice of either would not otherwise affect function of the device.

14. Claims 5, 6, 12, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of United Kingdom Patent Application No. GB 2 264 436 to Amey and further in view of WO 99/31171 to Hannacolor.

Although Bingle '131, as modified in view of Amey '436 does not teach the luminous body consisting of luminescent crystal mixture which is mixed with a transparent plastic material and/or is embedded therein, Hannacolor '171 teaches that it is well known to mold or extrude phosphorescent plastic articles from thermosetting resin ("transparent plastic material") and phosphorescent crystal pigments beginning page 3 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture the luminescent portion of the handle according to teachings of Hannacolor '171 in order to increase toughness and durability of the luminescent body portion while taking advantage of modern phosphorescent materials as would be recognized by one of ordinary skill in the art, and since it has been held to be within the general skill of a worker in the art to select a known material on the basis

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of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

15. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of United Kingdom Patent Application No. GB 2 264 436 to Amey and further in view of U.S. Pat. No. 5,129,694 to Tanimoto.

Bingle '131, as modified in view of teachings of Amey '436 does not disclose "gluing" the luminous body onto the basic body. However, Tanimoto '694 discloses that it is well known in the art of handles to glue a softer material portion of the desired color onto a handle base portion in order to provide a strong handle with the desired color. Not to overstate the point, but one of ordinary skill in the art would recognize that luminescent plastic materials are inherently softer than metal base materials and that choice of luminescent plastic of yellow, green, blue, etc is by identity, a choice in color. It would have been an obvious design choice for one of ordinary skill in the art at the time of the invention to mount the luminous portion of the the handle of Bingle '131, as modified in view of Amey '436, by gluing as taught by Tanimoto '694 in order to securely retain the luminous portion to the underlying basic portion.

16. Claims 3, 11, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of U.S. Pat. No. 1,762,447 to Lowes and further in view of U.S. Pat. No. 5,088,781 to Ono.

Bingle '131, as modified teaches the claimed invention except for attachment using a detent connection. Ono '781 teaches that it is well known in the art of handles to attach a first part to a base part using a detent connection. It would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to attach the luminous portion to the base portion using a detent connection as taught by Ono '781 in order to rapidly assemble a strong luminescent handle at reduced manufacturing cost or other design-related reason not affecting function of the resulting product.

17. Claims 3, 11, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of United Kingdom Patent Application No. GB 2 264 436 to Amey and further in view of U.S. Pat. No. 5,088,781 to Ono.

Bingle '131, as modified teaches the claimed invention except for attachment using a detent connection. Ono '781 teaches that it is well known in the art of handles to attach a first part to a base part using a detent connection. It would have been an obvious design choice or engineering expedient for one of ordinary skill in the art at the time of the invention to attach the luminous portion to the base portion using a detent connection as taught by Ono '781 in order to rapidly assemble a strong luminescent handle at reduced manufacturing cost or other design-related reason not affecting function of the resulting product.

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18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,086,131 to Bingle in view of U.S. Pat. No. 1,762,447 to Lowes and further in view of U.S. Pat. No. 5,088,781 to Ono and further in view of WO 99/31171 to Hannacolor.

Although Bingle '131, as modified, does not teach the luminous body consisting of luminescent crystal mixture which is mixed with a transparent plastic material and/or is embedded therein, Hannacolor '171 teaches that it is well known to mold or extrude phosphorescent plastic articles from thermosetting resin ("transparent plastic material") and phosphorescent crystal pigments beginning page 3 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture the luminescent portion of the handle according to teachings of Hannacolor '171 in order to allow for indicia to be laser marked thereon and since with or without laser marking, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

19. Claims 5, 16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,209,933 to Ang in view of WO 99/31171 to Hannacolor.

Although Ang '933 does not teach the luminous body consisting of luminescent crystal mixture which is mixed with a transparent plastic material and/or is embedded therein, Hannacolor '171 teaches that it is well known to mold or extrude phosphorescent plastic articles from thermosetting resin ("transparent plastic material")

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and phosphorescent crystal pigments beginning page 3 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture the luminescent portion of the handle according to teachings of Hannacolor '171 in order to allow for indicia to be laser marked thereon and since with or without laser marking, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

20. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,209,933 to Ang in view of U.S. Pat. No. 5,129,694 to Tanimoto.

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Ang '933, as modified in view of teachings of Amey '436 does not disclose "gluing" the luminous body onto the basic body. However, Tanimoto '694 discloses that it is well known in the art of handles to glue a softer material portion of the desired color onto a handle base portion in order to provide a strong handle with the desired color. Not to overstate the point, but one of ordinary skill in the art would recognize that luminescent plastic materials are inherently softer than metal base materials and that choice of luminescent plastic of yellow, green, blue, etc is by identity, a choice in color. It would have been an obvious design choice for one of ordinary skill in the art at the time of the invention to mount the luminous portion of the the handle of Ang '933, as modified in view of Amey '436, by gluing as taught by Tanimoto '694 in order to securely retain the luminous portion to the underlying basic portion.

Allowable Subject Matter

21. Claims 4, 8, 23, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

22. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

However, regarding argument against rejection under 35 USC 112, second paragraph is mistaken in that it is not rejected based upon its dependency, but rather because it is not clear if or how functional recitation of capability or intended use of the handle materially affects the scope of the claimed process. Is the process further defined, and if so, how? After reading the specification, one of ordinary skill in the art cannot be reasonably certain if the claim adds any further limitation to the process or not.

Argument against modification of Bingle '131 in view of Lowes '447 is not persuasive since contrary to arguments, the phosphorescent coated transparent member of Lowes '447 is a "luminous body". It is not clear if Applicant is arguing that it is not a "body" or that it is not "luminous" or that it is not mounted to a "basic body"? It is the examiner's position that the reference explicitly teaches broad limitations as it is relied upon in grounds of rejection. As regards strength of material, one of ordinary skill in the art should recognize the inherent need for a strong handle to avoid its being

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accidentally broken etc.. Applicant's argument that the base reference does not *explicitly* disclose that it should be modified to be strong or stronger are not persuasive.

Argument that materials including luminescent crystal mixtures are not well known are not consistent with prior art made of record. Otherwise conclusory statements regarding erroneous rejections and proper notice are noted but are not entirely persuasive.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,349,984 to Marrazzo.

U.S. Pat. No. 6,394,511 to Lam.

U.S. Pat. No. 6,555,215 to Pitts.

U.S. Pat. No. 6,692,659 to Brown.

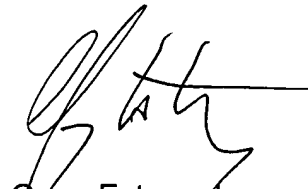
U.S. Pat. No. 6,716,368 to Schottland.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'G. Estremsky', with a long horizontal stroke extending to the right.

Gary Estremsky
Primary Examiner
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